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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/926,566	03/13/2002	Hiroshi Kayahara	216120US0PCT	8672
22850	7590	12/18/2003	EXAMINER	
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			FLOOD, MICHELE C	
			ART UNIT	PAPER NUMBER
			1654	

DATE MAILED: 12/18/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/926,566

Applicant(s)

KAYAHARA ET AL.

Examiner

Michele C. Flood

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-20 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 0303.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

The Office submits that Applicant should disregard the previous Office action requiring a restriction and submits the following in its stead:

Election/Restrictions

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claims 1-3, drawn to a prolylendopeptidase-inhibitive agent comprising an extract of a cereal grain as an active component.

Group II, claims 4-7, drawn to a method for preparing a prolylendopeptidase-inhibitive agent comprising extracting a cereal grain with water, organic solvent, or mixtures thereof.

Group III, claim 8, drawn to a compound of formula (II).

Group IV, claims 9-11, drawn to a method of preparing a compound of formula (II) comprising extracting a cereal grain and then isolating the compound from the extract.

Group V, claims 12-13, drawn to a prolylendopeptidase-inhibitive agent comprising the compound according to Claim 8 as an active component.

Group VI, claims 14 and 16, drawn to a germinated brown rice comprising prolylendopeptidase-inhibition activity.

Group VII, claim 15, drawn to a food product comprising the germinated brown rice according to claim 14.

Group VIII, claims 17-18, drawn to a method of preventing, reducing, treating, arresting, or alleviating cerebral dysfunction in a human or animal comprising administering the food product according to Claim 13 to a human or animal in which said preventing, reducing, treating, arresting, or alleviating is intended.

Group IX, claims 19-20, drawn to a method of preventing, reducing, treating, arresting, or alleviating cerebral dysfunction in a human or animal comprising administering the food product according to Claim 13 to a human or animal in which said preventing, reducing, treating, arresting, or alleviating is intended.

2. The inventions listed as Groups I-IX do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: Claims 1-6, 14 and 15, at least, are anticipated by or obvious over Saito et al., JP 10-77300 A, Saito et al., JP 9-40693 A, Saito et al., JP 9-37719 A, and Saito et al., Journal of Agricultural Food Chemistry (1997), 45: 720-724, because each of the cited patents and/or reference teach prolyl endopeptidase inhibiting activity in rice, and in maize, in soyabean, respectively, and the use thereof for treating disturbances of cerebral function. Therefore, they do not have a common technical feature over the prior art. With regard to Claim 13, the claim as drafted, does not necessarily *per se* relate to a compound

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having the claimed functional effect of prolyl endopeptidase inhibiting activity, wherein the compound is derived from a cereal grain extract. Moreover, Applicant has presented multiple inventions for prosecution on the merits. For instance, Applicant has claimed more than one product and claimed more than one method of using a product. Therefore, the claimed groups of inventions are not so linked as to form a single general inventive concept under PCT Rule 13.1.

Applicants are entitled to one product, one method of making a product, and one method of using a product; and, thus Applicant is required to elect one product, one method of making a product, and one method of using a product for prosecution on the merits.

3. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

4. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michele Flood whose telephone number is (703) 308-9432. The examiner can normally be reached on Monday through Friday from 7:15 am to 3:45 pm. Any inquiry of a general nature or relating to the status of this application

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should be directed to the Group 1600 receptionist whose telephone number is (703) 308-0196 or the Supervisory Patent Examiner, Brenda Brumback whose telephone number is (703) 306-3220.


MICHELE FLOOD
PATENT EXAMINER
MCF

December 15, 2003